

REMARKS

1. Applicant thanks the Examiner for his helpful comments and suggestions.
2. It should be appreciated that Applicant has elected to amend Claims 1-4, 6-23, and 25-28 solely for the purpose of expediting the patent process in a manner consistent with the PTO's Patent Business Goals, 65 Fed. Reg. 54603 (9/8/00). In making such amendments, Applicant has not and does not in any way narrow the scope of protection to which the Applicant considers the invention herein entitled. Rather, Applicant reserves Applicant's right to pursue such protection at a later point in time and merely seeks to pursue protection for the subject matter presented in this submission.

Hilton Davis / Festo Statement

Amendments herein to Claims 1-4, 6-23, and 25-28 were not made for any reason related to patentability. As for Claims 1-4, 6-23, and 25-28, changes were implemented to conform with standard claim drafting practices. None of the foregoing amendments is related to the pending rejections; all amendments were made for reasons other than patentability.

3. Claims 1-4, 6-23, and 25-28 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. patent application no. 2003/0169864 (hereinafter Lapstun).

Claims 1 and 2

As to Claim 2, the Examiner states that "Lapstun ... teaches that the information is entered and transferred via a Bluetooth-enabled pen (section [0138])." The Applicant respectfully disagrees with the Examiner's interpretation of section [0138]. Section [0138] of Lapstun teaches that a netpage printer communicates

with a telephone device using Bluetooth technology. Lapstun teaches that a netpage printer is a separate device from a netpage pen. As shown in Figure 2 and described in section [0098] of Lapstun, "the netpage pen ... communicates ... the interaction to a netpage printer. The printer 601 sends the interaction to the relevant page server." Hence, the netpage printer is performing communication with a page server. In order to distinguish Claim 1 from the recited reference more thoroughly, Applicant amends Claim 1 to incorporate the Bluetooth enabled pen subject matter of Claim 2 and to further limit Claim 1 by clarifying that said step of transferring couples said Bluetooth-enabled pen directly to a computer and via said computer to an online service provider. Support for these amendments are found in original Claim 2, in Figure 1, at page 6, lines 4-9, at page 8, lines 14-19, and in Figure 3. In stark contrast to the amended Claim 1, Lapstun does not teach a pen communicating with an online service provider; rather Lapstun teaches communicating via a netpage printer to a page server. First, it is general knowledge that a printer is not considered to be a user computer. Compounding with this general knowledge, Lapstun specifically teaches that a netpage printer is not a computer stating in paragraph [0096] lines 7-9 that "Unlike a personal computer, the netpage printer is an appliance." Hence, as amended Claim 1 teaches a method of connecting the pen to a Web server via a computer, which is specifically taught away from by Lapstun. Accordingly, the rejection of Claim 1 and all dependents therefrom under 35 U.S.C. § 102(e) as being anticipated by Lapstun is deemed to be overcome.

Claim 2

As to Claim 2, in view of the above mentioned amendments to parent Claim 1, the current rejection under 35 U.S.C. § 102(e) as being anticipated by Lapstun is rendered moot.

As to Claim 2, to distinguish the claimed invention from the recited reference more thoroughly, Applicant amends Claim 2 to further characterize the Bluetooth enabled pen as having a receiver device and a transmitter device. Support for this amendment is found at least at page 4, line 15 of the application as filed. Accordingly, the rejection of Claim 2 and all dependents therefrom under 35 U.S.C. § 102(e) as being anticipated by Lapstun is deemed to be overcome.

Claim 3

As to Claim 3, the Examiner cites Figure 2, items 10 and 101 and section [0138] as teaching the claimed step of "transferring the information from the first media to the second media via an ad-hoc network". Respectfully, the Applicant disagrees. None of the cited art of Figure 2, items 10 and 101 or section [0138] teaches an ad-hoc network. The common definition of an *ad hoc* solution is a solution formed or used for specific or immediate problems or needs. As described above, Section [0138] of Lapstun teaches that the netpage pen 10 communicates indirectly via a netpage printer with a netpage server 101. Lapstun teaches that a netpage printer is a separate device from a netpage pen. A netpage printer is a piece of hardware that it not typically thought of as portable. To support this, Lapstun teaches in section [0096] that "Unlike a personal computer, the netpage printer is an appliance which can be, for example, wall-mounted adjacent to an area where the morning news is first consumed, such as in a user's kitchen, near a breakfast table, or near the household's point of departure for the day." In stark contrast, the application as filed teaches *ad-hoc* point-to-point and point-to-multipoint wireless connections. Point-to-point wireless connections are not necessarily tied to a fixed piece of hardware, such as the netpage printer described in Lapstun. Accordingly, the rejection of Claim 3 and all dependents therefrom under 35 U.S.C. § 102(e) as being anticipated by Lapstun is deemed to be improper.

Claim 9

As to Claim 9, the Examiner cites Figure 2, items 10 and 101 and section [0138] as teaching the claimed step of "wherein the ad-hoc network is a Bluetooth network. Respectfully, the Applicant disagrees. None of the cited art of Figure 2, items 10 and 101 or section [0138] teaches an ad-hoc network. The common definition of an *ad hoc* solution is a solution formed or used for specific or immediate problems or needs. As described above, Section [0138] of Lapstun teaches that the netpage pen 10 communicates indirectly via a netpage printer with a netpage server 101. Lapstun teaches that a netpage printer is a separate device from a netpage pen. A netpage printer is a piece of hardware that is not typically thought of as portable. To support this, Lapstun teaches in section [0096] that "Unlike a personal computer, the netpage printer is an appliance which can be, for example, wall-mounted adjacent to an area where the morning news is first consumed, such as in a user's kitchen, near a breakfast table, or near the household's point of departure for the day." In stark contrast, the application as filed teaches ad-hoc point-to-point and point-to-multipoint wireless connections. Point-to-point wireless connections are not necessarily tied to a fixed piece of hardware, such as the netpage printer described in Lapstun. Accordingly, the rejection of Claim 9 and all dependents therefrom under 35 U.S.C. § 102(e) as being anticipated by Lapstun is deemed to be improper.

Claims 11-13 and 15

As to Claims 11-13 and 15, the Applicant respectfully disagrees. The Examiner cites only Figure 22 and the comment that "it is inherent that a user is capable of using his pen this way when writing a message." Figure 22 of Lapstun is for text entry. The description of Figure 22 in Lapstun at paragraph [0187] states that "Netpage converts the message to text". In stark contrast, the claimed invention includes the steps of entering information in Claim 3 and transferring the information in Claim 3. The entered information includes circling, underlining, highlighting, and selecting a word in Claims 11-13 and 15, respectively. While

the Examiner is correct that a pen may be used for circling, underling, highlighting, or selecting a word; the full requirement of the claims is that the information entered by the pen is transferred. Lapstun's conversion to text requirement teaches away from transferring the graphical information, such as circling as in Claim 11. The circling information is lost in the text conversion of Lapstun. Similarly, Lapstun's text conversion requirement teaches away from transferring marked-up information, such as underlining or highlighting as in Claims 12 and 13. Further, selecting a word as in Claim 15 is distinct from entering a word. Accordingly, the rejection of Claims 11-13 and 15 and claims dependent therefrom under 35 U.S.C. § 102(e) as being anticipated by Lapstun is deemed to be improper.

Claim 16

As to Claim 16, the Applicant respectfully disagrees with the construction of the claimed language used by the Examiner. The Examiner states that "a user is capable of writing the dictionary meaning of any word". This implies that the definition is being entered into a message by the user. In stark contrast, the claimed invention is to selecting a word as required in Claim 15 and providing a dictionary meaning for the selected word. Thus the claim is not directed at entering text. In stark contrast, the claim is to having a dictionary meaning provided for a selected word. Accordingly, the rejection of Claim 16 under 35 U.S.C. § 102(e) as being anticipated by Lapstun is deemed to be improper.

As to Claim 16, to clarify the meaning of Claim 16, Applicant amends Claim 16 to further characterize the step of providing as providing to a user the dictionary meaning of the selected word. Support for this amendment is found in the application as filed at least at page 7, line 26 to page 8, line 1. Accordingly, the rejection of Claim 16 under 35 U.S.C. § 102(e) as being anticipated by Lapstun is deemed to be overcome.

Claims 18 and 19

As to Claims 18 and 19, the Applicant respectfully disagrees. The Examiner cites only paragraph [0096] of Lapstun. Paragraph [0096] of Lapstun makes no mention of a tax form or of a purchase order. As Lapstun does not teach or describe a tax form or a purchase order, Lapstun can not anticipate these forms. Accordingly, the rejection of Claims 18 and 19 under 35 U.S.C. § 102(e) as being anticipated by Lapstun is deemed to be improper.

Claim 21

As to Claim 21, to distinguish the claimed invention from the recited reference more thoroughly, Applicant amends Claim 21 to further characterize the transmitter as transmitting directly to a computer connected to a Web server. Support for this amendment is found at least at page 8, lines 14-19 and in Figure 3. In stark contrast, Lapstun teaches a pen-connected to a netpage printer that is connected to a netpage server. First, a printer is not considered to be a user computer. Compounding this general knowledge, Lapstun specifically teaches that a netpage printer is not a computer stating in paragraph [0096] lines 7-9 that "Unlike a personal computer, the netpage printer is an appliance." Hence, as amended Claim 1 teaches an apparatus connection of the pen to a Web server via a computer, which is specifically taught away from by Lapstun. Accordingly, the rejection of Claim 21 and all dependents therefrom under 35 U.S.C. § 102(e) as being anticipated by Lapstun is deemed to be overcome.

Claims 22, 23, and 25-28

As to Claim 22, 23, and 25-28, in view of the above mentioned amendments to parent Claim 21, the current rejection under 35 U.S.C. § 102(e) as being anticipated by Lapstun is rendered moot.

4. Claims 1-4, 6-23, and 25-28 are amended to conform with standard claim drafting practices.

5. The specification is amended to correct a typographical error at page 9, line 1.

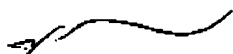
6. The specification is amended to expand a common abbreviation at Page 5, line 20 to page 6, line 2. Applicant avers that RF in the application at the cited location stands for radio frequency and that no new matter is added by way of this amendment to the specification.

7. New Claims 29-37 are added to the Application. Support for the new Claims 29 and 38 is found at least in original Claims 1, 3, and 21. Support for new Claims 30 and 40 is found in the application as filed at least at page 4, line 15. Support for new Claims 31 and 39 is found at least at page 5, lines 20 to page 6, line 2. Support for new Claims 32 and 33 is found at least at page 5, lines 22-23. Support for new Claim 34 is found at least at page 6, lines 18-19. Support for new Claim 35 is found at least in original Claim 2. Support for new Claims 36 and 37 is found in original Claim 2, in Figure 1, at page 6, lines 4-9, at page 8, lines 14-19, and in Figure 3. Support for new Claim 41 is found at least at page 5, line 24 to page 6, line 1. Support for new Claim 42 is found at least at page 4, lines 20-22. Applicant certifies that no new matter was added by way of the new claims.

CONCLUSION

In view of the above, the Application is deemed to be in allowable condition. The Examiner is therefore earnestly requested to withdraw all outstanding rejections and objections, allowing the Application to pass to issue as a United States Patent. Should the Examiner have any questions regarding the application, he is respectfully urged to contact Applicant's attorney at (650) 474-8400.

Respectfully submitted,



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